

REMARKS AND ARGUMENTS

Claims 4 and 5 are pending in the present application. Claims 1-3, 8, and non-elected claims 6-7 and 9-10 have been canceled. Claim 4 has been amended by rewriting it in independent form to incorporate all of the limitations of claim 1. Reference to "f", which was set equal to 0 in original claim 4, has been removed from the description of the catalyst incorporated from claim 1.

Claims 1-5 and 8 were rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicants respectfully traverse this rejection.

Applicants have described the general methods useful for production of the claimed catalysts on pages 6-7 and 10-14, as well as in the Examples, to enable one skilled in the art to prepare the claimed catalysts. Rejection of claims as being non-enabled requires "the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning" refuting the asserted teaching of the invention. *In re Marzocchi*, 439 F.2d 220, 224 (C.C.P.A. 1971). The present Office Action has not provided such evidence. It presents no facts to support the assertion that "undue experimentation" would be required to practice the present invention. The Office action merely states that there are not "sufficient working examples" to support the claims. However, Applicants are not required to present any examples at all, and the C.C.P.A. has stated that the claims may be supported "either by the use of illustrative examples or by broad terminology." *Id.* at 223. Applicants respectfully submit that the aforementioned teachings of their application provide the required support for the claims. The mere assertion that there is not "a sufficient number of compounds to support the relatively broad claims" has been rejected by the Board of Patent Appeals and Interferences, which reversed such an enablement rejection as "not supported by evidence, facts or sound scientific reasoning." *Ex parte Reese*, 40 U.S.P.Q.2d 1221 (B.P.A.I. 1996).

Moreover, reliance in the Office Action on *Ex parte Sizto* for the proposition that catalyst compositions are unpredictable is misplaced. In *Sizto*, the B.P.A.I. upheld an enablement rejection on the basis that "enzyme and non-enzyme catalysts are so divergent." *Ex parte Sizto*, 9 U.S.P.Q.2d 2081, 1988 Pat. App. LEXIS 26, *7 (B.P.A.I. 1988). The actual comment made by the B.P.A.I. regarding unpredictability was that the characteristics of "metal complexes and electron transfer agents as compared to enzymes" were unpredictable. *Id.* at *7-*8 (emphasis added). This case makes no general statement about unpredictability within a particular class of catalysts. There is no basis to assert that Applicants' claimed catalysts, which are all within the class of multi-metal oxides, could not be prepared by one of ordinary skill in the art. Therefore, Applicants respectfully

submit that the Office Action does not meet the burden of refuting the teaching of Applicants' disclosure, and that the rejection should be withdrawn.

Claims 1-5 and 8 were rejected provisionally for obviousness-type double patenting over Application Nos. 10/095,633 and 09/928,020. The same catalyst compositions are described in the claims of both cited applications; the latter has issued as Patent No. 6,403,525 ('525 patent). Applicants respectfully traverse this rejection, and will address the issued claims of the '525 patent. The claims of 10/095,633 have not issued, and in any case, do not recite a different catalyst composition from those of the '525 patent at this time.

The claims of the '525 patent require the presence of either In or Re (the choices for Z) in an amount of exactly 0.001 moles (subscript e), when a=1. In contrast, the catalyst claimed in the present invention can include In only as a choice for X in an amount from 0.01 to 1.0 (d), and cannot include Re at all. Therefore, only an In-containing catalyst claimed in the present application could even contain the same elements as a catalyst claimed in the '525 patent, but the amount of In would be at least ten times that of the '525 catalyst (0.01 to 1.0 vs. 0.001). There is no suggestion in the claims of the '525 patent that the In-containing catalyst should be modified by increasing the amount of In by at least ten-fold. Accordingly, Applicants respectfully submit that the present claims are not obvious over the claims of the '525 patent and that the double-patenting rejection should be withdrawn.

Claims 1-3, 5 and 8 were rejected under 35 U.S.C. § 102(a) over U.S. Pat. No. 6,043,186 to Komada et al. ("Komada"), which discloses a catalyst of formula: $\text{Mo}_{1.0}\text{V}_{0.34}\text{Nb}_{0.14}\text{Te}_{0.24}\text{Sm}_{0.013}\text{O}_n$. Applicants respectfully submit that the amended claims are patentable over Komada.

Original claim 4, which recited a catalyst containing Ir, but not Sm (f=0), was not rejected over Komada. Therefore, Applicants submit that the amended claim 4, incorporating the limitations of claim 1, on which original claim 4 depended, is patentable. Moreover, claim 5, which is dependent on claim 4, should be allowable as well.

Applicant notes that the claim to domestic priority under 35 U.S.C. § 119(e) made in a Preliminary Amendment at the time of filing was not acknowledged in the Office Action, and respectfully requests that it be acknowledged in the next communication from the Examiner.

Applicants believe that the foregoing amendments and remarks have overcome the rejections. However, if the Examiner has any further objections to the application, Applicants respectfully request that the Examiner contact Applicants'

undersigned attorney by telephone at (215) 592-2423 to discuss the remaining issues.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Kenneth Crimaldi".

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